

REMARKS

Status Of Application

Claims 1-16 and 18-20 are pending in the application; the status of the claims is as follows:

Claims 11-16, 19, and 20 are rejected under the first paragraph of 35 U.S.C. § 112, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1 and 6-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent No. 5,467,434 to Hower, Jr. et al. (hereinafter the "Hower patent"), U.S. Patent No. 6,088,120 to Shibusawa et al. (hereinafter the "Shibusawa patent"), and U.S. Patent No. 5,768,483 to Maniwa et al. (hereinafter the "Maniwa patent").

Claims 2-5 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of the Hower patent, the Shibusawa patent and Applicant's admitted prior art.

Claims 11, 15, 16, 19, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of the Hower patent and the Maniwa patent.

Claims 12-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of the Hower patent, the Maniwa patent and Applicant's admitted prior art.

35 U.S.C. § 112 Rejection

The rejection of claims 11-16, 19, and 20 under the first paragraph of 35 U.S.C. § 112, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly

connected, to make and/or use the invention, is respectfully traversed based on the following.

The limitations presented in claims 11 and 16 are clearly disclosed in and supported by the specification and figures. According to the specification on page 14, line 8 - page 15, line 5 and in Figures 4 and 6, the job data area C of the printer memory 104 stores job data (page 14, lines 8-12). When the server 6 registers a job, the mode is registered as individual job data in job data area C of the system RAM 104 (page 14, lines 21-25). The printer status is determined at the printer (page 14, line 25 - page 15, line 3), and when the server 6 requests job data, the job data area C of the printer memory is referenced (page 15, lines 2-5). "Data for printing sent via network N (page description language) is stored in system RAM 104... and a graphic image is developed in image RAM 106 based on an image drawing algorithm." Page 13, lines 8-12.

Therefore, **the limitations of claims 11 and 16, including those specifically mentioned in the Office Action, are clearly described in the specification** in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention. As claims 12-15 and 19 depend either directly or indirectly from enabled claim 11, they too are enabled by the disclosure. As claim 20 depends directly from enabled independent claim 16, it too is enabled by the disclosure.

Further, to support its § 112 rejection, the Office Action relies on the text on page 18, lines 7-10 and 14-19 of the specification. However, upon review of these paragraphs, it is clear that these sections of the specification have been either misunderstood or misinterpreted.

With respect to independent claim 11, and specifically with respect to the particular limitation of claim 11 discussed in the Office Action, that is:

such that the job management device can determine whether or not to route an input job having a specific mode to the image forming apparatus based on whether any of the jobs stored in the memory has the specific mode of the input job. (Emphasis Added.)

The Office Action states that: the “server 6 just select[s] a printer based on stored jobs in hard disk 206 of the server, not a memory of the printer, and printer status.” This is clearly a misinterpretation of the disclosure. The referenced section clearly states that “**Page description language used for printing** is recorded on hard disk 206, and job registration server 6 examines this content and ascertains the type of **sheet selection** for which control commands are included.” Additionally, this section clearly states that “Job registration server 6 also **ascertains** printer status and information **regarding jobs registered in printers 3 through 5** connected to network N, and job registration server 6 handles processing to select an appropriate printer **based on stored jobs...**” (i.e., **jobs stored in the printer memory**) “**and printer status.**” That is to say, the job registration server checks **the printer memory (not its own memory)** to find out about stored jobs and printer status. In other words, the job registration server 6 **does not** select a printer based on stored jobs in its **own** attached hard disk (206), as was stated in the Office Action. Instead, the job registration server 6 acquires this information from the printers themselves.

Likewise, with respect to claim 16, and specifically the referenced limitation of claim 16:

wherein when said input job has a specific mode, said control device selects an image forming apparatus whose memory stores a job having the specific mode of the input job,
(Emphasis Added).

the cited specification passage is either misunderstood or misinterpreted. Clearly, the passages on page 14 discussed above describe the limitations claimed in claim 16. Nowhere in the specification, including in the cited reference passage page 18, lines 7-10 and 14-19, is this limitation contradicted.

Therefore, as **the limitations of claims 11 and 16, including those specifically mentioned in the Office Action, are clearly described in and therefore supported by the specification** in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention, and as there is no contradiction of these claim limitations

presented within the specification, the limitations of claims 11 and 16 are enabled by the specification. As claims 12-15 and 19 depend either directly or indirectly from enabled claim 11, they too are enabled by the disclosure. As claim 20 depends directly from enabled independent claim 16, it too is enabled by the disclosure.

Accordingly, it is respectfully requested that the rejection of claims 11-16, 19, and 20 under the first paragraph of 35 U.S.C. § 112, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, be reconsidered and withdrawn.

35 U.S.C. § 103(a) Rejections

The rejection of claims 1 and 6-10 under 35 U.S.C. § 103(a) as being unpatentable over the combination of the Hower patent, the Shibusawa patent, and the Maniwa patent, is respectfully traversed based on the following.

The Office Action relies on a combination of references in order to support its § 103(a) rejection of claims 1 and 6-10 of the present application. As was acknowledged in the Office Action, the Hower reference “**does not** teach each of at least two of printers has a specific mode” as is required by claim 1. (Emphasis Added). Further, as was acknowledged in the Office Action, “**neither Hower nor Shibusawa** teach a printer stores its own information such as properties”. (Emphasis Added.) In addition, none of the cited references, alone or in combination, shows or suggests any type of selection based on whether the image forming apparatus “stores a prior job having the specific mode of the input job at the time the selection is made...”. That is to say, neither the Hower patent nor the Shibusawa patent disclose or suggest a controller which selects an image forming apparatus which stores (is storing) a print job having the specific mode. The Office Action states that the Hower reference teaches that the controller selects an image forming apparatus which has the specific mode at the time the selection is made. This is clearly different from a controller that selects an image forming apparatus which **stores a print job having the specific mode** of the input job at the time the selection is made”.

Therefore, claim 1 is neither anticipated by nor obvious with respect to any of the above cited references (including the Hower patent) either alone or in any combination.

More importantly, there is no suggestion or motivation to combine the Hower and the Shibusawa references, nor would the combination of Hower and Shibusawa provide the device of claim 1 of the present application. Therefore, claim 1 would not be obvious over the combination of these two references. Further, even if the device of Maniwa were found to have a memory for storing jobs, there is no suggestion or motivation to combine the Maniwa reference, the Hower reference, and the Shibusawa reference, nor would such a combination provide the device of claim 1 of the present application.

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination [or modification].” MPEP 2143.1 (7th Ed. 1998) (Citations omitted) (emphasis in original). “A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made”” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.” MPEP 2143.1 (7th Ed. 1998) (Citations omitted) (emphasis in original).

Therefore, claim 1 is not obvious with respect to the Hower patent, the Shibusawa patent, or the Maniwa patent either singly or in any combination. “If an independent claim is nonobvious under 35 U.S. C. 103, then any claim depending therefrom is nonobvious.” MPEP 2143.03 (7th Ed. 1998) (Citations omitted). As claims 6-10 depend either directly or indirectly from non-obvious independent claim 1, they too are not obvious with respect to the Hower patent, the Shibusawa patent, or the Maniwa patent either singly or in any combination.

Accordingly, it is respectfully requested that the rejection of claims 1 and 6-10 under 35 U.S.C. § 103(a) as being unpatentable over the combination of the Hower patent, the Shibusawa patent, and the Maniwa patent, be reconsidered and withdrawn.

Claims 2-5 and 18

The rejection of claims 2-5 and 18 under 35 U.S.C. § 103(a) as being unpatentable over the combination of the Hower patent, the Shibusawa patent, and Applicant's admitted prior art, is respectfully traversed based on the following.

Claims 2 and 18 depend directly from non-anticipated, non-obvious independent claim 1, which is not obvious with respect to the Hower patent, the Shibusawa patent, or the Maniwa patent either singly or in any combination. Therefore, claims 2 and 18 are also not obvious with respect to the Hower patent, the Shibusawa patent, and the Maniwa patent either singly or in any combination. As claims 3-5 depend indirectly from non-obvious independent claim 1 through non-obvious dependent claim 2, they too are not obvious with respect to the Hower patent, the Shibusawa patent, or the Maniwa patent either singly or in any combination.

Further, as was acknowledged in the Office Action, the combination of Hower and Shibusawa **does not** teach a mode for temporarily stopping the image forming apparatus in order to exchange sheets or change paper in a manual feeding, or notify a user to place an indicated type of paper, as is required in claim 2. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP 2143.03 (7th Ed. 1998) (Citations omitted) (emphasis in original). Therefore, claim 2 is not obvious, and claims 3-5 which depend therefrom are not obvious, with respect to the Hower patent, the Shibusawa patent, or the Maniwa patent, either singly or in any combination.

Still further, there is no suggestion or motivation to combine the references, nor would such a combination provide the apparatus of claim 1. "The mere fact that references can be combined or modified does not render the resultant combination obvious

unless the prior art also suggest the desirability of the combination [or modification].” MPEP 2143.1 (7th Ed. 1998) (Citations omitted) (emphasis in original). “A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made”” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.” MPEP 2143.1 (7th Ed. 1998) (Citations omitted) (emphasis in original).

Therefore, even if Applicant’s admitted prior art were to teach the limitation of claim 2, as claim 1 is not obvious over the above cited references or the Applicant’s admitted prior art, claim 2, which depends therefrom, is also not obvious with respect to the combination of the above cited prior art. As claims 3-5 depend from non-obvious dependent claim 2, which depends directly from non-obvious independent claim 1, they too are not obvious with respect to the Hower patent, the Shibusawa patent, or the Maniwa patent either singly or in any combination. Further, as claim 18 depends directly from non-obvious claim 1, it too is not obvious with respect to any combination of the above referenced prior art.

Accordingly, it is respectfully requested that the rejection of claims 2-5 and 18 under 35 U.S.C. § 103(a) as being unpatentable over the combination of the Hower patent, the Shibusawa patent, and Applicant’s admitted prior art, be reconsidered and withdrawn.

Claims 11, 15, 16, 19, and 20

Claims 11, 15, and 19

The rejection of claims 11, 15, 16, 19, and 20 under 35 U.S.C §103(a) as being unpatentable over the combination of the Hower patent and the Maniwa patent, is respectfully traversed based on the following.

Claim 11 is directed to an image forming apparatus and requires in relevant part:

a memory for storing jobs;
discriminating means for discriminating whether any of the jobs stored in the memory has a specific mode in order to determine a status of the memory; and
reporting means for reporting the status of the memory to the job management device such that the job management device can determine whether or not to route an input job having a specific mode to the image forming apparatus based on whether any of the jobs stored in the memory has the specific mode of the input job.

In direct contradiction to the argument presented in the Office Action, having a server which stores a plurality of modes of each of the printers (of Hower) is **not** comparable to a printer which reports to the server whether any of the jobs stored in the memory has a specific mode (as in claim 11 of the present application). Nor is such a limitation disclosed or suggested by either the Hower patent or the Maniwa patent. Therefore, this limitation is **not** rendered obvious by either the Hower patent or the Maniwa patent.

Further, as was acknowledged by the Office Action, Hower **does not** teach “the printer having reporting means for reporting the status of memory which indicates a specific mode in the stored job to the server.” Nor is such a limitation disclosed or suggested by the Maniwa patent. Therefore, this limitation is **not** rendered obvious by either the Hower patent or the Maniwa patent.

Further, there is no suggestion or motivation to combine the Hower patent and the Maniwa patent, nor would such a combination provide the apparatus of claim 11. Therefore, claim 11 is not obvious with respect to the Hower patent or the Maniwa patent, either singly or in combination.

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination [or modification].” MPEP 2143.1 (7th Ed. 1998) (Citations omitted) (emphasis in original). “A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time

the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.” MPEP 2143.1 (7th Ed. 1998) (Citations omitted) (emphasis in original).

Therefore, claim 11 is not obvious with respect to the Hower patent or the Maniwa patent either singly or in combination. As claims 15 and 19 depend either directly or indirectly from non-obvious independent claim 11, they too are not obvious with respect to the Hower patent or the Maniwa patent either singly or in combination.

Claims 16 and 20

Claim 16 is directed to a network system and comprises in relevant part:

discriminating means for discriminating a status of the memory based on whether the memory stores a job having a specific mode;
reporting means for reporting to the network the status of the memory of any of the plurality of image forming apparatuses whose memory stores a job having a specific mode; and ...
wherein when said input job has a specific mode, said control device selects an image forming apparatus whose memory stores a job having the specific mode of the input job. (Emphasis Added.)

As was acknowledged in the Office Action, Hower **does not** teach “the printer having reporting means for reporting the status of memory which indicates a specific mode in the stored job to the server.” None of the other cited prior art references teaches or suggests such a limitation. Therefore, claim 16 is not obvious with respect to Hower or any of the other cited references.

Further, there is no suggestion or motivation to combine the Hower patent and the Maniwa patent, nor would such a combination provide the system of claim 16. Therefore, claim 16 is not obvious with respect to the Hower patent or the Maniwa patent, either singly or in combination.

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination [or modification].” MPEP 2143.1 (7th Ed. 1998) (Citations omitted) (emphasis in original). “A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made”” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. MPEP 2143.1 (7th Ed. 1998) (Citations omitted) (emphasis in original).

Therefore, claim 16 is not obvious with respect to the Hower patent or the Maniwa patent either singly or in combination. As claim 20 depends from non-obvious claim 16, it too is not obvious with respect to the Hower patent or the Maniwa patent either singly or in combination.

Accordingly, it is respectfully requested that the rejection of claims 11, 15, 16, 19, and 20 under 35 U.S.C §103(a) as being unpatentable over the combination of the Hower patent and the Maniwa patent, be reconsidered and withdrawn.

Claims 12-14

The rejection of claims 12-14 under 35 U.S.C. § 103(a) as being unpatentable over the combination of the Hower patent, the Maniwa patent, and Applicant’s admitted prior art, is respectfully traversed based on the following.

Claims 12-14 depend either directly or indirectly from non-obvious independent claim 11, which as discussed previously, is not-obvious with respect to the Hower patent, the Maniwa patent, either singly or in combination. Further, claim 11 is not obvious with respect to the prior art cited by the Applicant, either singly or in combination with either the Hower patent or the Maniwa patent. Therefore, claims 12-14, which depend therefrom, are also not obvious with respect to the Hower patent or the Maniwa patent, or the prior art cited by the Applicant, either singly or in any combination.

Further, as was acknowledged in the Office Action, the combination of the Hower patent and the Maniwa patent **does not** teach a mode for temporarily stopping the image forming apparatus in order to exchange sheets or change paper in a manual paper feeding, or notify a user to place an indicated type of paper, which is required in claim 12. “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” MPEP 2143.03 (7th Ed. 1998) (Citations omitted) (emphasis in original). Therefore, claim 12 is not obvious, and likewise claims 13 and 14 which depend therefrom are not obvious, with respect to the Hower patent, the Maniwa patent, or the prior art cited by the Applicant, either singly or in any combination.

Still further, there is no suggestion or motivation to combine the references, nor would such a combination provide the apparatus of claim 11, and thereby claims 12-14 of the present application.

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination [or modification].” MPEP 2143.1 (7th Ed. 1998) (Citations omitted) (emphasis in original). “A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made”” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.” MPEP 2143.1 (7th Ed. 1998) (Citations omitted) (emphasis in original).

Accordingly, it is respectfully requested that the rejection of claims 12-14 under 35 U.S.C. § 103(a) as being unpatentable over the combination of the Hower patent, the Maniwa patent, and Applicant’s admitted prior art, be reconsidered and withdrawn.

Response to Arguments

(1) With respect to the Hower reference, it appears that the term, “job ticket”, as used in the Hower patent has been incorrectly correlated with the term “print job” as used in the present application. As described in the present application, a “print job” is a request for printing processing (in the form of a job) that has been sent from a computer to be printed by one of a plurality of image forming apparatuses. (page 9, lines 18-24). However, according to the Hower patent, as discussed in col. 4, lines 5-27 and shown in Figures 4 and 5, the term “job ticket” is merely properties of the printer which allow the user to select media description parameters and finishing options viewed on a screen. A job ticket is **not** a print job. Therefore, there is no correlation between the “job ticket” of Hower and “print job” of the present application.

(2) The following responds to each argument in detail.

Claim 1

Claim 1 is directed to a device for selecting a network-connected image forming apparatus from a plurality of network-connected image forming apparatuses, where each of at least two of the plurality of image forming apparatuses has a specific mode, the device comprising:

a controller for selecting one of the plurality of image forming apparatuses connected with the network,
wherein when an input job has a specific mode, said controller selects **an image forming apparatus** which has a specific mode and **which stores a prior job having the specific mode of the input job at the time the selection is made**, said prior job being stored in a memory of the image forming apparatus; and
said controller for **registering the input job in the memory of the selected image forming apparatus**. (Emphasis Added)

That is, claim 1 required that the image forming apparatus **stores** a prior job having the specific mode of the input job at the time the selection is made and when the controller selects the image forming apparatus, the input job is **registered in** the selected image forming apparatus. The criteria used by the device for the selection of the image forming

apparatus, which will print the input job, is which of the image forming apparatuses has a specific mode and also stores a prior job having the specific mode of the input job. None of the prior art references, either singly or in combination, teaches or suggests a device for selecting an image forming apparatus as claimed above.

It is asserted in the Office Action that the limitation of “the memory of the printer” is not to be read into claim 1. In support of this assertion, *In Re Van Geuns*, 988 F.2d 1181, 26 W.S.P.Q 2d 1017 (Fed. Cir. 1993) has been cited. In response, it is asserted that the Van Geuns’ reference has been misinterpreted and misapplied in this case, and the application of Van Geuns in this case is without merit.

In Van Geuns, a patentee, Van Geuns, who had an unfavorable ruling in an interference proceeding based on newly discovered prior art, wanted the scope or breadth of his claims to be construed narrowly by the court from a potentially broad realm of applications in a variety of possible arts to one particular application of the claimed invention in one particular art by including a previously unclaimed limitation in order to get around the newly cited prior art. Van Geuns admitted the prior art disclosed what Van Geuns had originally claimed. Van Geuns reasoned that such narrowing interpretation was acceptable because the claims “must be interpreted in light of the specification and the understanding of persons skilled in the . . . art”. (Van Geuns @ 1184.) Van Geuns alleged that the desired narrower interpretation of the claim was supported by the specification.

However, in *Van Geuns*, the court upheld the Board’s finding of obviousness on grounds that even if the scope of the claims had been so narrowed as Van Geuns requested, the claims would still have been obvious in light of the newly cited prior art thereby precluding Van Geuns from filing a narrowing reissue application. The court also held that Van Geuns did not argue sufficiently to permit a determination that the claims were not invalid.

Based on the holding in *Van Geuns*, it appears that a court will not automatically read an **additional** limitation into a claim even if the specification would have supported such a limitation, in order for a patentee to get around newly cited prior art in an interference proceeding when the newly cited art would also render the narrower claims

obvious. Further, had the newly cited prior art not also have been held to have rendered the claims obvious even with the additional limitation, Van Geuns would not have been precluded from thereby filing a narrowing reissue application to sufficiently narrow the scope of his claims.

With respect to the claims of the present application, one skilled in the art would logically understand that when an apparatus “stores” or “registers” data or jobs transmitted to it via a network, the storage takes place in a “memory” of the apparatus unless an alternate location is specifically identified. Therefore, no reference need be made to the “memory of the printer”, nor would inclusion of this language affect the scope of the claim or the realm of reasonable interpretations or breadth of the claim limitations.

Claims 11 and 16

As to the assertion that the limitation “of discriminating means for discriminating a status of the memory based on whether the memory stores a job having a specific mode” is not to be supported by anywhere in the specification of the application”, it is assumed that the Examiner has changed direction and is at this time arguing in reference to limitations of claims 11 and 16. Further, it is assumed that this argument is a § 112 rejection.

In response to the assertion above, Figure 7 clearly shows that the job registration server requests information from and receives information from the various printers. The information requested and returned includes the “existence” of previously stored jobs and the “attributes” of the previously stored jobs. Page 15, lines 3-5, states, “When job registration server 6 requests job data, the contents of job data area C are referenced and made known to job registration server 6”. As is later disclosed, part of this information is whether any of the jobs stored in the printer are specific mode jobs. (Page 20, lines 6-9). Page 18, line 20 - page 19, line 5 (with reference to Fig. 7), states: “printers return ‘attributes for all stored jobs’ ... to job registration server 6 which issued the request”. Clearly these passages describe that the printer discloses information regarding the job data stored in the printer memory to the job registration server including a determination of whether or not any of the jobs stored in the printer memory have a specific mode. It is

logical, and one skilled in the art would understand, that if a server requests that the printer return information related to whether or not any of the jobs stored in a printer have a specific mode, the printer must make a determination (i.e., Yes or No) prior to responding to the server's request. Therefore, this limitation is clearly supported by the specification.

CONCLUSION

Wherefore, in view of the foregoing remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

Any fee required by this document other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee,

and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's
Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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